

REMARKS

Claims 1-11 and 31-51 are presently pending in the application. The Examiner has stated that he considers claims 37, 40-43 and 47 to be withdrawn.

At the outset, Applicants respectfully traverse the finality of the present Office Action. The Examiner contends that Applicants' amendment necessitated the new grounds of rejection presented in the Office Action. However, the rejection of claim 49 (corresponding to original claim 30) under 35 U.S.C. § 102(a) is the first prior art rejection of this claim. While Applicants' amendment did add the structural formulas corresponding to compounds 44, 46, 48, 50, and 52, the amendment did not change the fact that these are all fluorinated compounds (see pages 110, 117, and 118). Therefore, Applicants' incorporation of the structures into the claim responsive to the rejection under § 112 did not introduce fluorine into the claims for the first time and could not have necessitated this new ground of rejection.

Accordingly, it is respectfully requested that the finality of the present Office Action be withdrawn.

Response to Restriction Requirement

In Paper No. 9, the Examiner argues that newly submitted claims 37, 40-43, and 47 are directed to an invention that is independent or distinct from the invention originally claimed since they read on non-halogenated compounds. Accordingly, the Examiner contends that since an action on the merits has been received for the originally present invention, this invention has been constructively elected, and claims 37, 40-43, and 47 have been withdrawn from consideration as being directed to a non-elected invention. Applicants respectfully traverse this restriction.

New claims 37, 40-43, and 47 correspond to original claims 18, 21-24, and 28, respectively, differing only in recitation of the structural formula that had previously been

described only with text. Claims 18, 21-24 and 28 have always read on non-halogenated compounds, and were not previously subjected to a restriction requirement. Since Applicants' previous amendments merely rewrote these claims to incorporate the chemical structures depicted in the specification, they have not changed the scope of the claims. This subject matter having already been examined, their *de facto* restriction in the present Office action is improper, and withdrawal is respectfully requested. Accordingly, Applicants respectfully request that the Examiner reinstate claims 37, 40-43 and 47, and withdraw the restriction requirement.

Rejections Under § 102(a)

The Examiner has rejected claims 4, 9, 11, 32, 39, 45, 49, and 51 under 35 U.S.C. § 102(a) as being anticipated by (C89) ("Anzenbacher") or Sessler (C100) ("Sessler"). The Examiner argues that while the parent application teaches halogen, it does not support the specific compounds where the substituents are fluorine (F). Previously, the Examiner argued that these references are available because they are by "others." Applicants respectfully traverse these rejections on at least two grounds:

(1) the references are not properly cited as prior art under § 102(a) as they are not a publication by "others;" and

(2) the references are not properly cited as prior art under § 102 as they have a publication date after the priority date of the claims against which they are cited.

The cited references do not qualify as prior art under 35 U.S.C. § 102(a) as being by "others." As set forth in MPEP § 715.01(c), "a rejection based on a publication may be overcome by a showing that it was published by applicants himself/herself or on his/her behalf." Further, if the applicant is one of the co-authors of the cited publication:

...the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 C.F.R. § 1.132 establishing that the article is describing

applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. § 102(a). (MPEP § 715.01(c))

In the present situation, as set forth in the Declaration of Jonathan L. Sessler under 37 C.F.R. § 1.132 ("the Sessler Declaration"), filed herewith, Applicants are the co-authors of the cited Sessler and Anzenbacher references. However, the other co-authors were not the inventors of the subject matter described and claimed in the present application (and thus are not co-inventors of the present application). Rather, these individuals merely worked under the direction of one of the Applicants, Jonathan L. Sessler. Therefore, since it has been shown that the cited references are publications of Applicants' own invention, were published by Applicants themselves to describe Applicants' own work, and that the other non-inventor co-authors were merely working under Applicants, the cited references are not by "others". Accordingly, neither of Anzenbacher or Sessler is properly cited as prior art against the claims of the present application, and reconsideration and withdrawal of the § 102(a) rejections are respectfully requested.

Additionally, the claims at issue are entitled to the benefit of the priority date of the parent application because the subject matter of the claims was described in the patent application. The Examiner's conclusion that the parent application does not support the compounds having a fluorine (F) substituent is in error. To the contrary, the parent application discloses compounds in which the R substituents defined by paragraph i) (parent application at page 9, lines 1-18) include halides. The halide substituents contemplated by the invention are expressly identified as "chlorine, bromine, fluoride, and iodide" (parent application at page 22, lines 19-20). Further, Example 10 of the parent application describes the attachment of electron-withdrawing substituents (such as bromine) to the carbon rim. Those skilled in the art will appreciate that such electron-withdrawing halide substituents also include fluoride and chloride.

Indeed, the only halide generally not considered to be suitable as an electron-withdrawing substituent is iodide. (See, for example, col. 2, lines 43-45 of U.S. Patent No. 5,599,928 of Sessler (one of the Applicants of the present application), attached, which states that, "Electron-withdrawing groups include halide other than iodide...".) Applicants thus submit that no fair basis exists to presume that disclosure of halides in the parent application would be considered by one skilled in the art as limited to the specifically exemplified halide, bromine, and not to support fluorine. If anything, one skilled in the art might infer the exclusion of iodine as an electron-withdrawing group, but certainly not fluorine. Applicants thus respectfully submit that persons of ordinary skill in the art would appreciate that the parent application encompassed those compounds in which the halide was fluoride because of both the explicit disclosure of the same and the knowledge of one of skill in the art. Therefore, the present application is entitled to the benefit of the priority date for the subject matter of at least rejected claims 4, 9, 11, 32, 39, 45, 49, and 51.

Accordingly, since Applicants are entitled to the benefit of parent application 08/883,379, filed June 26, 1997, and since both of the cited prior art references, Anzenbacher and Sessler were published subsequently to the priority date of the present application (October 7 and November 15, 2000, respectively), neither Anzenbacher nor Sessler is prior art for any claim which is supported in the parent application, including claims 4, 9, 11, 32, 39, 45, 49, and 51.

In view of the preceding Remarks and Sessler Declaration, it is respectfully submitted that all of the pending claims are distinct from the cited prior art of record and in condition for allowance. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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Enclosure: Petition for Extension of Time (two months)
Declaration of Jonathan L. Sessler under 37 C.F.R. § 1.132